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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/700,425      | 11/05/2003  | Dorothea R. Smith    | SMITHD-1            | 5695             |

32132 7590 04/15/2005

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| EXAMINER |
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WONG, STEVEN B

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3711

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/700,425

Applicant(s)

SMITH, DOROTHEA R.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins (6,619,661). Regarding claim 11, Collins discloses a jigsaw puzzle comprising a puzzle framework (40A-40L) that defines an interior and a plurality of puzzle pieces (30A-30D, 20) that are placed within the framework. Collins discloses arithmetic indicia on both the framework and pieces (note Figure 2). The puzzle pieces are seen as being added upon a life event occurring (the user figuring out the proper solution to the arithmetic equation. Regarding the added limitation for the event to be a “life event” that “may or may not occur in a person’s life” such a limitation relates to the meaning and information conveyed by the printed matter. The differences between the printed matter of the instant invention and that of the puzzle of Collins relates to the meaning and information conveyed by the printed matter and such differences are not considered to be patentable differences.

Regarding claim 12, the framework comprises a plurality of framework pieces.

Regarding claim 13, the limitation for the pieces to be directed to life principles relates to the indicia and the meaning conveyed by the indicia.

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guill (4,417,732). Guill discloses a jigsaw puzzle game comprising a framework (11) and a plurality of puzzle pieces (14-23) having indicia thereon. The game includes dice (35) that upon rolling indicate a particular piece of the puzzle to be placed within the framework. The rolling of the dice is seen as a life event. Regarding the added limitation for the event to be a “life event” that

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“may or may not occur in a person’s life” such a limitation relates to the meaning and information conveyed by the printed matter. The differences between the printed matter of the instant invention and that of the puzzle of Guill relates to the meaning and information conveyed by the printed matter and such differences are not considered to be patentable differences.

4. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (723,425). Note the basis of the rejections set forth in the Office Action mailed September 22, 2004. Regarding the added limitation to claim 1 for the event to be a major event that “may or may not occur” in one’s life, this limitation relates to the meaning and information conveyed by the printed matter. The difference between the e applicant’s game and the game of Thompson reside in the meaning and information conveyed by the printed matter and such differences are not considered to be patentable differences.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guill (4,417,732). Attention is directed to the basis for the rejection of claim 12 in the Office Action mailed September 22, 2004.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guill (4,417,732) in view of Hall, Jr. et al. (6,708,973). Attention is directed to the basis to the basis for the rejection of claim 13 in the Office Action mailed September 22, 2004.

#### ***Response to Arguments***

7. Applicant's arguments filed January 27, 2005 have been fully considered but they are not persuasive. Regarding claim 11, the applicant contends that Collins lacks the teaching for a life event that may or may not occur in a person’s life. The pieces are only added if they correspond to a life event that has occurred. However, this is not persuasive as the differences between the

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prior art and the claimed invention reside only in the meaning and information conveyed by the printed matter itself. Collins teaches a puzzle wherein a user adds a puzzle piece when a life event occurs (the user figuring out the solution to the addition equation). The recitation that the life event be a birthday, graduation day or wedding day relates to the printed matter itself.

Lacking any new and unexpected relationship between the printed matter and the substrate itself, the printed matter does not carry any patentable weight. Attention is directed to *In re Gulack* CAFC 217 USPQ 401 and *Ex Parte Breslow* 192 USPQ 431. The “critical question is whether there exists any new and unobvious functional relationship between printed matter and substrate.” Here, a new and unobvious functional relationship between the printed matter and substrate does not exist and thus, the printed matter does not carry any patentable weight. Also, patentable novelty cannot be predicated upon printing alone, but must reside in physical structure. *In re Sterling* 21 CCPA 1134, 70 F.2d 910. Clearly, the instant invention and the printed matter recited therewith does not meet these standards and thus does not carry any patentable weight.

Regarding the rejection of claim 11 over Guill, the applicant argues that Guill fails to anticipate the claim language for the same reasons as Collins. However, this is not persuasive for the reasons stated above where the particular printed matter does not define a new and unobvious relationship with the substrate and therefore, does not carry any patentable weight.

Regarding claims 1-9, the applicant argues that Thompson also lacks the teachings to render obvious the claim language because he lacks the printed matter that represents a major life event. However, as stated above, this language does not carry any patentable weight and thus, the teachings of Thompson render the claimed structure obvious.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

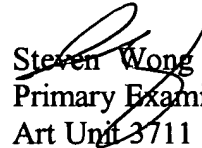
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
April 11, 2005